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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,186	09/25/2006	Jose Barbosa Mendes Jr	40296-10010	7100
21788 7590 08/18/2008 RYNDAK & SURI LLP 200 W. MADISON STREET SUITE 2100 CHICAGO, IL 60606				
EXAMINER				
BLATT, ERIC D				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/594,186

**Applicant(s)**

MENDES JR ET AL.

**Examiner**

Eric Blatt

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, Jr. (US 6,863,675) in view of Berube et al. (US 2004/0106937).

Regarding claims 5-9, 11, 12, 16-21, and 23, Wilson recites a surgical clip (Figures 1, 2) comprising: a pair of curved legs 22, 24 wherein each leg has an inner surface and an outer surface and each leg has a shape that is generally a mirror image of the shape of the other leg; a flexible articulation 38 joining the pair of legs at one end, the legs being movable about the flexible articulation from an open position to a closed position such that the inner surfaces of the legs are parallel and in contact with one another when the clip is in the closed position; and a locking mechanism 42, 44 at a second end of the pair of legs for securing the legs together in a closed position. The locking mechanism comprises a pin 42 at the free end of one leg and an orifice 46 at the end of the other leg, the pin being adapted to snap fit under pressure into the orifice. Each leg includes a plurality of teeth 76 on its inner surface. The teeth 76 are transversely oriented on each leg. The clip is formed of polymer material. (Column 2, Lines 40-50) The flexible articulation 38 is integral with the legs. One leg has at least

one protrusion 42 on its inner surface and the other leg having at least one recess 46 on its inner surface, the protrusion 42 and recess 46 being adapted to fit together when the clip is in a closed position.

Regarding the limitation that the legs are 'laterally curved,' in the previous action on the merits mailed February 7, 2008, Examiner held, "the direction the legs extend in is considered a longitudinal direction, and any direction perpendicular to this direction may be considered lateral depending upon the angle at which the clip is held." Applicant has submitted that this definition of 'lateral curvature' is not consistent with the Applicant's figures and specifications. Examiner notes that Applicant has not included any explicit special definition in the instant specification and therefore, Examiner may take a broadest reasonable interpretation of the term 'laterally curved.' Examiner maintains that the legs of the clip disclosed in Wilson may be reasonably considered to be laterally curved. Regarding the limitation that the clip is adapted to be applied to an anatomical structure such that when the clip is in the closed position, the clip either partially or fully occludes the structure depending on the angle at which the clip is applied to the structure, Examiner notes that this limitation is functionally recited. Thus, this recitation requires only that the clip is **capable of** being provided in a closed position such that it **either** partially or fully occludes the structure depending on the angle at which the clip is applied to the structure. Examiner holds that the clip of Wilson is capable of being applied to an anatomical structure in a closed position at an angle such that it fully occludes the anatomical structure, and that the clip of Wilson therefore fully meets this limitation.

Alternatively, Berube discloses a surgical clip (Figures 1 and 4) comprising legs that are laterally curved in the sense suggested by Applicant's submitted figures. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by providing the legs such that they are laterally curved as taught by Berube since this curvature was a known alternative and its substitution would not have produced unexpected results. So modified, the clip is adapted to be applied to an anatomical structure such that when in the closed position, the clip either partially or fully occludes the structure depending upon the angle at which the clip is applied to the structure.

Regarding claim 10, Wilson discloses all elements of claim 10 except that the clip is formed of metal. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the clip be formed of metal since metal was known by those of skill in the art as an accepted material from which to form medical clips.

Regarding claims 13-15, and 24, Wilson discloses all elements of said claims except that one leg includes a longitudinal ridge on its inner surface and the other leg includes a longitudinal recess on its inner surface, the ridge being adapted to fit within the recess when the clip is in the closed position. Wilson does disclose a transverse ridge 76 and a transverse recess (indentation between ridges on opposing leg), the ridge being adapted to fit within the recess when the clip is in the closed position. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the ridge and recess be provided

longitudinally since such a modification would have merely constituted a rearrangement of the existing parts of the device.

Regarding claims 9 and 22, Wilson discloses all elements of claims 9 and 22 except that the teeth are longitudinally oriented on each leg. Rather, Wilson shows that the teeth are transversely oriented on each leg. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Wilson by having the teeth be oriented longitudinally on each leg since such a modification would have merely constituted a rearrangement of the existing parts of the device.

### ***Response to Arguments***

Applicant's arguments with respect to claims 5-24 have been considered but are moot in view of the new ground(s) of rejection.

See pages 3 and 4 of this action for a discussion of the interpretations of the term 'lateral curved' and the limitation that the clip is adapted to be applied such that it either partially or fully occludes an anatomical structure.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

Eric Blatt  
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